P21745.P06

GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Attorney Docket No. P21745

In re application of : Andrew LILBURN

Serial No. : 10/050,167 Group Art Unit: 1731

Filed : January 18, 2002 Examiner: S. Alvo

For : PROCESS AND APPARATUS FOR MONITORING DEWATERING IN A WET SECTION OF A PAPER MACHINE

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
A Request for Extension of Time.
X No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 49	49*	0	x 9=	$	x 18=	$0.00
Indep. Claims: 2	*3*	0	x 42=	$	x 84=	$0.00
Multiple Dependent Claims Presented			+140=	$	+280=	$0.00
Extension Fees for Month				$		$0.00
			Total:	$	Total:	$0.00

*If less than 20, write 20
**If less than 3, write 3

Please charge my Deposit Account No. 19-0089 in the amount of $.
N/A A Check in the amount of $ to cover the *filing/extension* fee is included.
X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
X Any additional filing fees required under 37 C.F.R. 1.16.
X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Neil F. Greenblum
Reg. No. 28,394

35,043

#5/BM 4-10-03

P21745.A02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew LILBURN

Group Art Unit: 1731

Appln. No. : 10/050,167

Examiner: S. Alvo

Filed : January 18, 2002

For : PROCESS AND APPARATUS FOR MONITORING DEWATERING IN A WET SECTION OF A PAPER MACHINE

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Examiner's restriction requirement of March 6, 2003, the time set for response being one month from the mailing date from the U.S. Patent and Trademark Office, i.e., April 7, 2003 (April 6, 2003 being a Sunday), Applicant hereby elects the invention of Group I, including claims 1 - 33. The above election is made with traverse for the reasons set herein below:

In the Official Action of March 6, 2003, the Examiner indicated that all claims (1 - 49) were subject to restriction under 35 U.S.C. § 121. The Examiner restricted the claimed invention into Group I, including claims 1 - 33, drawn to a process for monitoring dewatering of the web, classified in class 162, subclass 198 and Group II, including claims 34 - 49, drawn to a monitoring apparatus, classified in class 162, subclass 263.

The Examiner asserted that the inventions were related as process and apparatus for its practice, and that the inventions are distinct from each other under M.P.E.P. § 806.05(e) because the "apparatus does not have to measure water from the paper machine, but could be used to measure coatings from a paper-coating machine." Thus, the Examiner asserts that the "apparatus of Group II could be used to measure liquids other than water."

Applicant initially notes that "water flowing" within the apparatus claims is not a "method step," as asserted by the Examiner, but specifically defines the measuring device. That is, independent claim 34 specifically recites a device *measuring water flowing into* the wet end section and a device for *measuring water flowing out* of the wet end section, which refers to devices for measuring flowing water. Thus, while flowing water, *per se*, may not be accorded patentable weight in the examination of an apparatus, the devices measuring water flow must be accorded due weight in the examination of the apparatus.

Further, Applicant notes that independent claim 34 specifically recites two devices arranged to measure flowing water, and the Examiner's assertions that such an apparatus could be used to measure coatings is unclear. In particular, it appears as if the Examiner has merely pointed to one (or two) specifically recited element in Applicant's apparatus claims as having another use, instead of asserting that the entire apparatus can be used to perform another process.

Thus, Applicant submits that the Examiner has failed to show that the process and

apparatus are distinct under M.P.E.P. § 806.05(e), and, therefore, has not show that the asserted restriction requirement is proper.

Further, Applicant respectfully submits that the Examiner has omitted one of the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. That is, as set forth in M.P.E.P. § 803, "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if the restriction requirement were not required.

While the Examiner has alleged a possible distinction between the two identified groups of invention, the Examiner has not shown that a concurrent examination of these groups would present a "serious burden" on the Examiner. In fact, as the Examiner has acknowledged that the individual groups would be classified in the same class 162, there is no appropriate statement that the search areas required to examine the invention of group I would not overlap into the search areas for examining the invention of group II, and vice versa.

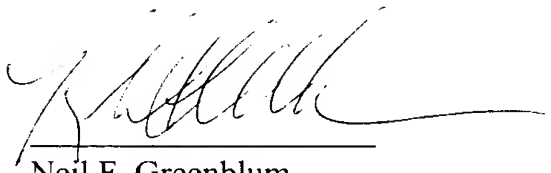
Thus, Applicant respectfully submits that the search for the combination of features recited in the claims of the above-noted groups, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the same, Applicant submits that no undue or serious burden would be presented in concurrently examining Groups I and II. Thus, for the above-noted reasons, and

consistent with the office policy set forth above in M.P.E.P. § 803, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement in this application.

For all of the above reasons, the Examiner's restriction is believed to be improper. Nevertheless, Applicants have elected, with traverse, the invention defined by Group I, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should the Examiner have any questions or comments, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Andrew LILBURN



Neil F. Greenblum
Reg. No. 28,394

April 7, 2003
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191